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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/656,630

09/05/2003

David J. Parins

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EXAMINER

HOEKSTRA, JEFFREY GERBEN

ART UNIT

PAPER NUMBER

3736

MAIL DATE

DELIVERY MODE

05/23/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/656,630	<b>Applicant(s)</b> PARINS, DAVID J.	
	<b>Examiner</b> JEFFREY G. HOEKSTRA	<b>Art Unit</b> 3736	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 February 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) 34-46 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,5-9,11,13-17,19,21-25,27 and 29-32 is/are rejected.
- 7) ☒ Claim(s) 2,4,10,12,18,20,26,28 and 33 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>04/04/08</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Notice of Amendment***

1. In accordance with the Panel Decision from Pre-Appeal Brief Review mailed 04/04/2008, the current final rejections of claim(s) 1-33 set forth in the Office Action mailed 11/01/07 is/are *withdrawn*. The following new grounds of rejection are set forth:

### ***Claim Objections***

2. Claims 8 and 16 are objected to because of the following informalities: the positive recitations of “a element” in line 2 appear to contain a typographical and/or grammatical error and should apparently read “an element”. Appropriate correction is required.

3. Claim 26 is objected to because of the following informalities: the positive recitation of “a plurality of discrete affixation points” in lines 1-2 appears to duplicate the “a plurality of discrete affixation points” structure of claim 25 and may render the claim indefinite. The Examiner notes Applicant may have intended to positively recite “the plurality of discrete affixation points”. Appropriate correction is required.

4. Claim 30 is objected to because of the following informalities: the positive recitations of “the discrete affixation point” in lines 1-2 should apparently read “each discrete affixation point”. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 3, 5-7, 9, 11, 13-15, 17, 19, 21-23, 25, 27, and 29-31 are rejected under 35 U.S.C. 102(b) as being anticipated by Tartacower et al. (US 5,606,981, hereinafter Tartacower).

7. For claims 1, 9, 17, and 25, Tartacower discloses and shows an intracorporal medical device (as best seen in Figure 5), comprising:

- an elongate shaft (10) (column 8 lines 12-33) having a proximal end (the proximal end element 10) (as best seen on the left side in Figure 5) and an opposing distal end (the distal end element 10) (as best seen on the right side in Figure 5);
- a helically wound coil (50) (column 8 line 66 – column 9 line 47) having a plurality of windings (as best seen in Figure 5) forming a coil length (as best seen in Figure 5) disposed about a portion of the distal end of the elongate shaft (column 8 lines 66-67) (as best seen in Figure 5);
- a thermoplastic polymer tube (81) (column 9 lines 39-47) circumferentially disposed about a portion of the coil length (as best seen in Figure 5); and
- a plurality of discrete affixation points (located about elements 82 and 84, which are the proximal and distal ends of the thermoplastic polymer tube 81 attached to the coil 50) (column 9 lines 48-60) disposed along the coil length (as best seen in Figure 5), wherein each discrete affixation point fixes the thermoplastic polymer sleeve to two or more coil windings (as best seen in Figure 5), wherein each discrete affixation point is separated from other discrete affixation points by areas where the polymer

sleeve is not affixed to the coil (column 9 line 61 – column 10 line 9) (as best seen in Figure 5).

8. For claims 3, 11, 19, and 27, Golds discloses and shows an intracorporal medical device (as best seen in Figure 2), wherein the plurality of discrete affixation points forms a non-uniform pattern (the singular discrete affixation point of the tube to the multiple coil windings) along the coil length (as best seen in Figure 2).

9. For claims 5, 13, 21, and 29, Tartacower discloses and shows an intracorporal medical device (as best seen in Figure 5), wherein the plurality of discrete affixation points forms a uniform pattern (the two discrete affixation points of the tube to the multiple coil windings) along the coil length (as best seen in Figure 5).

10. For claims 6, 14, 22, and 30, Tartacower discloses and shows an intracorporal medical device (as best seen in Figure 5), wherein the discrete affixation point fixes 3 coil windings to the thermoplastic sleeve (as best seen in Figure 5).

11. For claims 7, 15, 23, and 31, Tartacower discloses and shows an intracorporal medical device (as best seen in Figure 5), wherein each discrete affixation point is a discrete element aligned orthogonal to the windings (as best seen in Figure 5).

***Claim Rejections - 35 USC § 103***

12. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

13. Claims 8, 16, 24, and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tartacower. Tartacower teaches an intracorporal medical device, wherein each discrete affixation point has a length of 0.5 to 2 cm (column 9 lines 55-56).

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It would have been an obvious matter of design choice to a person of ordinary skill in the art to modify the size of the plurality of discrete affixation points along the length of an intracorporal medical device as taught by Tartacower with a width of 0.1 to 0.5 mm and a length of 0.1 to 0.3 mm, because Applicant has not disclosed that a width of 0.1 to 0.5 mm and a length of 0.1 to 0.3 mm provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the size of the plurality of discrete affixation points along the length of an intracorporal medical device as taught by Tartacower, because it provides a secure means for attaching a thermoplastic polymer tube to a plurality of coil windings (column 9 lines 39-60) and since it appears to be an arbitrary design consideration which fails to patentably distinguish over Tartacower. Therefore, it would have been an obvious matter of design choice to modify Tartacower to obtain the invention as specified in the claim(s).

***Allowable Subject Matter***

14. Claims 2, 4, 10, 12, 18, 20, 26, 28, and 33 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

15. For claims 2, 10, 18, and 26, the following is a statement of reasons for the indication of allowable subject matter: The prior art does not disclose, teach, and/or fairly suggest an intracorporal device, comprising *inter alia*: a thermoplastic polymer tube affixed with 10 discrete affixation points or regions to two or more windings of a coil.

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16. For claims 4, 12, 20, 28, and 33, the following is a statement of reasons for the indication of allowable subject matter: The prior art does not disclose, teach, and/or fairly suggest an intracorporal device, comprising *inter alia*: a thermoplastic polymer tube affixed to two or more windings of a coil with a plurality of discrete affixation points or regions to a plurality of windings of a coil, wherein the plurality of discrete affixation points has a density of discrete affixation points per unit coil length that decreases from the proximal end to the distal end.

### ***Response to Arguments***

17. Applicant's arguments with respect to claims 1-33 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JEFFREY G. HOEKSTRA whose telephone number is (571)272-7232. The examiner can normally be reached on Monday through Friday 8am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (571)272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J.H./

Jeff Hoekstra  
Examiner, Art Unit 3736

/Max Hindenburg/

Supervisory Patent Examiner, Art Unit 3736